

In re Application of MOORE et al.
Serial No. 09/742,795

REMARKS

The Office action has been carefully considered. The Office action issued a restriction requirement requesting that the applicants choose between Group I (claims 1-30) and Group II (claims 31-34). During an October 8, 2005 telephone conversation with the applicants' attorney, Group I was provisionally elected. Applicants hereby affirm this provisional election of Group 1 and formally cancel claims 31-34 (Group II).

Regarding the elected claims, the Office action rejected claims 1-4, 10-20, and 22-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,711,557 to Palaniappan et al., ("Palaniappan"). Further, the Office action rejected claims 5-6, 8-9, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Palaniappan in view of Japanese Patent No. 09-288572 to Yasui et al. ("Yasui"). Further yet, the Office action rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Palaniappan in view of Yasui and further in view of U.S. Patent No. 5,944,821 to Angelo et al. ("Angelo"). Regarding the rejections, applicants respectfully disagree.

By present amendment, claims 1, 17, and 27 have been amended for clarification and not in view of the prior art. Claims 31-34 are cancelled without traverse. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

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Applicants thank the Examiner for the interview held (by telephone) on November 18, 2005. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed to a system and method for facilitating automatic software updates from an online source such as the Internet without being required to have a connection established to the online source in order to determine whether an update (e.g., a driver or software component) is available or is not available. Information relating to available online updates (and lack thereof) may be stored in a local cache whereby each available update may correspond to drivers and/or other software components. See generally, pages 16 and 17 of the specification. That is, information that an update is available online is stored as well as information that an update is not available online. Thus, when a particular application may need to check for the availability of an update, instead of establishing a connection to the online source, the local cache may be accessed to determine if there is, in fact, an update that may need to be retrieved from the online source. See pages 17 to 18 of the specification. It may also be definitively determined by accessing the local cache that an update is, in fact, not available. Further, if the machine state changes before a connection is made so that an update is no longer applicable, the update information in the offline cache can be

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used to give the user correct information regarding the status of updates. See page 22 of the specification. In this manner, if no update may be needed as determined from the information stored in the local cache, a connection to the online source may not need to be made. See pages 16-18 of the specification.

This may be especially beneficial for computers and/or computer users who do not always have access to a network, such as the Internet or an enterprise intranet. When a device may be installed or software components may be detected, instead of requiring a connection to enable updates, the cached information may be evaluated to determine whether the update is available online. If so, the user may defer making the connection, for instance, and the update may happen automatically and/or in the background on the next online connection.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

§102(e) Claim Rejections

Turning to the claims, amended claim 1 generally recites obtaining information about the availability of at least one updates and obtaining information about the unavailability of at least one update from a server, storing the information about available and unavailable updates at a local cache on the client computer, and in response to a request for update information that may be available at the server, accessing the local cache to retrieve the information about available updates and unavailable updates.

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The Office action rejected claim 1 as being anticipated by Palaniappan. More specifically, the Office action contends that Palaniappan discloses at a client computer, obtaining information about available updates from a server. Column 2, lines 10-17 of Palaniappan is referenced. Further, the Office action contends that Palaniappan discloses storing the information about available updates at a local cache on the client computer. Column 3, line 52 through column 4, line 2 of Palaniappan is referenced. Finally, the Office action contends that Palaniappan discloses, in response to a request for update information that may be available at the server, accessing the local cache to retrieve the information about available updates. Column 4, lines 10-15, lines 23-35, and lines 49-52 are referenced. Applicants respectfully disagree.

Palaniappan is directed, generally, to a system and method for providing update information about several programs by accessing online sources to determine the availability of those potential updates. In fact, by requiring a connection to the Internet (or other online source) in order to periodically scan for updates as they become available, Palaniappan is an example of a very problem that the present invention is capable of overcoming. Palaniappan, in direct contrast to the recitations of claim 1, does not store any information related to the unavailability of updates. Rather, Palaniappan only asks a single question with regard to an available update. See Fig. 3, step 310 of Palaniappan. If the yes branch is undertaken, then an update is downloaded. However, Fig. 3 of Palaniappan does not have a "no" branch and presumes that if no is the answer then the update process terminates. This strongly suggests that Palaniappan has

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not considered any alternatives, but in any event, Palaniappan's silence cannot be reasonably construed as teaching the storing information about an unavailable update.

In contrast, claim 1 gnearily recites storing information about available updates and unavailable updates at a local cache on the client computer, and in response to a request for update information that may be available at the server, accessing the local cache. Information about available updates as well as unavailable updates may be retrieved from an online source at some prior point in time (before the request for update information) such that any retrieved information can be made available in a local cache at a later point in time (e.g., in response to a request for update information). In essence, the method of claim 1 may be interpreted as answering up to at least two questions about available updates (as opposed to just one with Palaniappan), namely whether there an available update and whether there is no available update.

This inherent dual question format of claim 1 has a significant advantage over the teachings of Palaniappan. Both systems may ask the question as to whether an available update exists and if so, then download the available updates. However, in Palaniappan, if the answer is no, Palaniappan terminates, whereby there is no definitive way to know that an update does not exist, only that an update was not indicated in the most recent download of information. The method of claim 1 goes beyond the limitations of Palaniappan by definitely answering the reciprocal question of whether there is no update available. Information indicating no available update allows a user to rest assured that no update exists, (i.e., the

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second question is definitively answered). Clearly, Palaniappan is wholly unconcerned with the reciprocal question. Thus, for at least the foregoing reasons, applicants submit that claim 1 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 2-4 and 10-16, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Palaniappan fails to disclose the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 3 recites the computer-implemented method of claim 1 wherein obtaining information about available updates from the server includes obtaining data that changes the information about available updates in the local cache. As discussed above, Palaniappan does not store information about both the availability and unavailability of updates in a local cache. Consequently, Palaniappan cannot possibly teach obtaining further information that may change the information already stored in the local cache. Applicants submit that claim 3 is allowable for at least this additional reason.

Turning to the next independent claim, amended claim 17 generally recites network access software configured to access a network, a cache, a cache maintenance mechanism connected to the network access software and configured to maintain information in the cache, the information corresponding to available updates maintained on the network and corresponding to unavailable

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updates not maintained on the network, and automatic update software connected to access the cache in response to a request for update information on the network, and to determine from the information in the cache whether an update is available or not available.

The Office action rejected claim 17 as being anticipated by Palaniappan. More specifically, the Office action contends that Palaniappan discloses the recitations of claim 17 for primarily the same reasons and citations as were given with respect to claim 1. Applicants respectfully disagree.

As discussed above, the method and system disclosed in Palaniappan does not definitely answer the question as to whether an update is not available, and no such information relating specifically to unavailable updates is stored anywhere at any time in Palaniappan's model. Thus, Palaniappan cannot possibly teach a cache maintenance mechanism connected to the network access software and configured to maintain information in the cache, the information corresponding to available updates maintained on the network and corresponding to unavailable updates not maintained on the network. Rather, in Palaniappan, information about available updates is only stored at the various server computers of the very online sources associated with the makers of each individual application to be updated. Once again, Palaniappan is wholly unconcerned with definitely establishing that an update is not available. For at least these reasons, applicants submit that claim 17 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 18-20 and 22-26, by similar analysis, are allowable. Each of these claims depends either directly or

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indirectly from claim 17 and consequently includes the recitations of independent claim 17. As discussed above, Palaniappan fails to disclose the recitations of claim 17 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 17 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 27 generally recites accessing an online source to obtain information related to available updates and information related to unavailable updates, caching the information, the information including information as to the availability and the unavailability of updates, receiving a request directed to whether a particular update is available for download from the online source; and accessing the cache to determine whether the particular update is available or is not available for download from the online source.

The Office action rejected claim 27 as being anticipated by Palaniappan. More specifically, the Office action contends that Palaniappan discloses the recitations of claim 27 for primarily the same reasons and citations as were given with respect to claims 1 and 17. Applicants respectfully disagree.

Claim 27 recites a computer-readable medium having computer executable instructions, comprising, accessing an online source to obtain information related to available updates and information related to unavailable updates. As previously discussed, Palaniappan does not teach dealing with information about the availability and unavailability of updates. That is to say, Palaniappan only definitively answers the question of whether or not an update is available by setting

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a single bit. Claim 27 recites language directed to answering two questions; whether an update is available, and whether an update is unavailable. This is different than Palaniappan. Indeed, Palaniappan's single bit could not hold such an additional state data.

Furthermore, claim 27 recites accessing the cache to determine whether the particular update is available or is not available for download from the online source. As discussed above, Palaniappan does not access a local cache to answer this question. Rather, Palaniappan must access each respective online source for each application in order to definitively set an update bit indicating an available update. Thus, for at least these reasons, applicants submit that claim 27 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 28-30, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 27 and consequently includes the recitations of independent claim 27. As discussed above, Palaniappan fails to disclose the recitations of claim 27 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 27 noted above, each of these dependent claims includes additional patentable elements.

§103(a) Claim Rejections

The Office action rejected claims 5-9 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Palaniappan in view of either Yasui and Angelo, or some combination thereof. Regarding claims 5-6 and 8-9 that were rejected under 35

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U.S.C. § 103(a) as being unpatentable over Palaniappan in view of Yasui, applicants submit that each of these claims depend either directly or indirectly from claim 1 and consequently include the recitations of claim 1. As discussed above, Palaniappan fails to disclose the recitations of claim 1. Nor does Yasui disclose the recitation of claim 1. Neither Palaniappan nor Yasui, whether considered alone or in any permissible combination with each other or any other prior art of record, teaches or suggests the recitations of claim 1, and, therefore, dependent claims 5-6 and 8-9 are also allowable over Palaniappan and Yasui. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Palaniappan in view of Yasui and further in view of Angelo. Claim 7 depends indirectly from claim 1 and consequently includes the recitations of claim 1. As discussed above, Palaniappan fails to disclose the recitations of claim 1. Yasui fails to disclose the recitations of claim 1. Similarly, Angelo fails to disclose the recitations of claim 1. Neither Palaniappan, Yasui, nor Angelo, whether considered alone or in any permissible combination at law, teaches or suggests the recitations of claim 1, and, therefore, dependent claim 7 is also allowable over Palaniappan, Yasui, and Angelo.

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Palaniappan in view Yasui. Claim 21 depends indirectly from claim 17 and consequently includes the recited limitations of claim 17. As discussed above, Palaniappan fails to disclose the recitations of claim 17. Therefore, dependent

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claim 21, which include the recited limitations of claim 17, are also allowable over Palaniappan even if considered in view of Yasui, (assuming such a combination is legally permissible), as the teachings of Palaniappan and Yasui, whether considered alone or in any permissible combination at law, fail to teach or even remotely suggest the recitations of claim 17.

For at least the reasons discussed above with respect to the §102 and §103 rejections, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

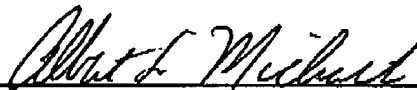
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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-30 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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I hereby certify that this Amendment, along with transmittal, petition for extension of time, credit card payment form and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: January 18, 2006


Albert S. Michalik

2690 Third Amendment